IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	Ferdinand Hendriks, et al.	**Examiner:**	Duyen My Doan
Serial No:	10/081,941	**Art Unit:**	2152
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For:	INK INSTANT MESSAGING WITH ACTIVE MESSAGE ANNOTATION	**Dated:**	September 17, 2007

Confirmation No: 4472

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF ON BEHALF OF PATENT OWNER

Sir:

This reply brief addresses points raised by the Examiner in the Examiner's Answer mailed July 16, 2007, and the reasons why the Examiner has erred and why the final rejection in the Office Action dated October 12, 2006 of claims 1-55 of the above-identified patent application should be reversed.

CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this paper is being electronically transmitted to the Patent and Trademark Office on the date shown below.

Dated: September 17, 2007

Steven Fischman

ARGUMENT

Introduction

The present application discloses and claims annotating instant text messages in an instant messaging system. Independent claims 1, 19, 36 and 53 recite, inter alia, "providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field; displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session; directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record..." According to the claim language in those claims, the same recording field can include one or more instant text messages as well as handwritten stroke information. Furthermore, the handwritten stroke information can be input anywhere within the recording field such that the handwritten stroke information can be used to annotate the text messages. Examples of a recording field having both text and handwritten messages are disclosed in Figures 2, 3, 5C.

Response to Examiner's Response to Argument

(1) Appellants in their Appeal Brief have explained in detail why Shiigi (U.S. Patent No. 6,564,249) and Sun (U.S. Patent Publication No. 2002/0143994) do not disclose, suggest or teach at least, "displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session; directly inputting handwritten stroke information

message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record."

In response, the Examiner alleges that "Shiigi teaches a graphical input area and this graphical input area is equivalent to the input record as claimed... The only different [sic] is the input area in Shiigi is in an email system, not a chat record... However, in the same field, Sun discloses a chat system having the capability inputting the handwritten message." The Examiner misinterprets Shiigi. Contrary to the Examiner's assertion, the only difference is not that the input area in Shiigi is in an email system. Shiigi also fails to disclose, suggest or teach that its input area can display text messages as well as handwritten messages, the handwritten messages capable of being anywhere in the input area.

While Shiigi discloses a graphical capture area for entering and capturing handwritten messages, this graphical capture area is solely for handling handwritten email messages. Shiigi does not disclose or suggest that this graphical capture area also displays a text message, whether it is an email text message or an ongoing instant text message. Rather, Shiigi is concerned with sending and receiving graphical email independent and separate from any text messages. Shiigi confirms this point in its col. 12, lines 8-11 enunciating, "The invention allows users to communicate using handwriting input *rather* than text input" (emphasis added). See also, Shiigi's col. 2, lines 12-14, which underscores disadvantages of using typed text and expresses: "There is thus a clear need for an electronic messaging system that allows people to communicate with their own handwriting or drawing, *as contrasted to typed text*"

(emphasis added). To reiterate, therefore, the difference in Shiigi is not only that it is an email system. Shiigi also does not disclose, suggest or teach to "directly input" handwritten stroke or other information message objects anywhere within the recording field having instant text messages from a currently ongoing instant text messaging session to thereby annotate the instant text messages in the chat record, as claimed in independent claims 1, 19, 36 and 53.

Similarly, while Sun appears to discuss communicating ink data using the current chat and instant messaging infrastructure, Sun like Shiigi also does not disclose, suggest or teach "directly inputting handwritten stroke information message objects anywhere within said recording field," which recording field also displays one or more instant text messages, "to thereby annotate said one or more instant text messages..." While Sun as understood by appellant discloses using instant messaging interface or infrastructure to send and receive ink data (See Sun, FIG. 7 and accompanying description), Sun still falls short of disclosing, suggesting or teaching, "directly inputting" ink data "anywhere" into a recording field having instant message text to thereby annotate said one or more instant text messages in said chat record. That is, Sun like Shiigi simply fails to disclose, suggest or teach mixing or co-existence of the two types of messages (ink data and text data) in the same recording field. There is no evidence or suggestion in Shiigi and Sun for such a configuration.

(2) Appellants also disagree with the Examiner's contention that Shiigi and Sun are combinable. Shiigi, in col. 11, lines 36-40, plainly differentiates its email handwritten messaging from other real time communication system such as chat sessions and instant

messaging systems, specifically enumerating in the following paragraphs (col. 11, line 41 – col. 12, line 24) the differences and disadvantages of the other real time communication system as compared to its email messaging system. A person of ordinary skill in the art, therefore, would not reasonably consider combining Shiigi with Sun's instant messaging system.

CONCLUSION

The above reasons preclude Shiigi and Sun, and the rest of the references from rendering claims 1-55 obvious under 35 U.S.C. §103(a).

Dated: September 17, 2007

Respectfully submitted,

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